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| 10/772,081 | 02/03/2004 | Holger Bohle | 09282.0044-00 | 1661 |
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| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | SENSENIG, SHAUN D | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--------------------------------------|
| Office Action Summary | Application No. 10/772,081 | Applicant(s) BOHLE, HOLGER |
| | Examiner Shaun Sensenig | Art Unit 3629 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) none is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 03 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 20040304, 20040524, 20040809, 20040927, 20050227, and 20051207.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-8**, drawn to a program, are rejected under 35 U.S.C. 101 because they fail to satisfy the requirements for statutory subject matter eligibility because they are considered to be drawn merely to the production and/or manipulation of non-functional descriptive material. To be statutory, a computer program must be coupled with or combined with some statutory physical structure, which is indeed the case with the instant claims, but also which is in fact not *necessarily* the case with the instant claims, since the claims read on just a source code file (non-functional descriptive material) stored on a computer readable medium, as opposed to machine executable instructions (functional descriptive material). It has been held that such claims, even if the non-functional descriptive material is claimed in combination with a computer-readable medium, are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea, and are therefore considered software *per se* and do not constitute patentable subject matter. *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). See MPEP §2106.01(l). As described in the specification, the "information carrier" may be a signal, which is not statutory subject matter.

3. **Claims 9-16** are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must entail the use of a specific machine or transformation of an

article which must impose meaningful limits on the claim's scope to impart patent-eligibility. *See Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. *See Parker v. Flook*, 437 U.S. 584, 590 (1978). The "curriculum management system", as presented in claim 9, performs the insignificant extra-solution activity of receiving and determining without performing any processing activities. Moreover, while the claimed process contains physical steps (scheduling, receiving, determining, processing), it does not involve transforming an article into a different state or thing. Therefore, Applicants' claim is not drawn to patent-eligible subject matter under § 101.

Claim Rejections - 35 USC § 112, First Paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 3 and 11** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to describe how a "successful" inconsistency check is determined (line 6).

Claim Rejections - 35 USC § 112, Second Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-8** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A computer readable medium containing a computer program is claimed, however, the computer program is not executed. Applicant should add execution of the program to the claim. For example "...computer program product that when executed performs operations..."

8.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-6 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Schloss et al. (Patent Number 5,692,125) (hereafter referred to as Schloss).**

11. In regards to **Claims 1 and 9**, Schloss discloses:

A computer program product, tangibly embodied in an information carrier, for use with a curriculum management system that manages a curriculum comprised of at least a course, the computer program product being operable to cause data processing apparatus to perform operations comprising:

- (a) scheduling a booking of the course for a learner; (Abstract, lines 1-2, *shows a scheduling system*)
- (b) receiving input requesting a modification to the booking; (Abstract, lines 12-13, *shows modification of scheduled event*)
- (c) determining whether the booking is an individual booking or a curriculum booking; (Column 11, lines 9-12, *checks to see if the first event has any subsequent connected events: no would show an individual booking and yes would show a curriculum booking*) and
- (d) processing the modification based on whether the booking is an individual booking or a curriculum booking. (Column 11, lines 9-12, *checks to see if there are any subsequent connected events and processes accordingly*)

12. In regards to **Claims 2 and 10**, Schloss discloses:

A computer program product, tangibly embodied in an information carrier, for use with a curriculum management system that manages a curriculum comprised of at least a course, the computer program product being operable to cause data processing apparatus to perform operations, wherein:

- (a) the modification comprises re-booking; (Column 8, lines 40-41) and

(b) if the booking is a curriculum booking, processing the modification comprises not re-booking the course. (Claim 2 and Claim 8, *shows that if condition is NOT met (such as NOT a curriculum course), the modification IS performed (such as DO rebook the course)*)

13. In regards to **Claims 3 and 11**, Schloss discloses:

A computer program product, tangibly embodied in an information carrier, for use with a curriculum management system that manages a curriculum comprised of at least a course, the computer program product being operable to cause data processing apparatus to perform operations, wherein:

(a) the modification comprises re-booking the course; (Column 8, lines 40-41)
and

(b) if the booking is an individual booking, processing the modification comprises: (Column 11, lines 9-12)

(i) performing a consistency check with respect to other courses in the curriculum; (Claim 8) and

(ii) if the consistency check is successful, re-booking the course. (Claim 8)

14. In regards to **Claims 4 and 12**, Schloss discloses:

A computer program product, tangibly embodied in an information carrier, for use with a curriculum management system that manages a curriculum comprised of at least a course, the computer program product being operable to cause data processing apparatus to perform operations, wherein:

(a) the modification comprises canceling the course; (Column 8, lines 40-41) and

(b) if the booking is a curriculum booking, processing the modification comprises not canceling the course. (Claim 2 and Claim 8, *shows that if condition is NOT met (such as NOT a curriculum course), the modification IS performed (such as DO rebook the course)*)

15. In regards to **Claims 5 and 13**, Schloss discloses:

A computer program product, tangibly embodied in an information carrier, for use with a curriculum management system that manages a curriculum comprised of at least a course, the computer program product being operable to cause data processing apparatus to perform operations, wherein:

(a) the modification comprises canceling the course; (Column 8, lines 40-43) and
(b) if the booking is a curriculum booking, processing the modification comprises: (Column 8, lines 40-43)

(i) canceling the course; (Column 8, lines 40-43)
(ii) identifying other courses for which bookings are invalidated by canceling the course; (Column 8, lines 40-43) and
(iii) canceling the other courses. (Column 8, lines 40-43)

16. In regards to **Claims 6 and 14**, Schloss discloses:

A computer program product, tangibly embodied in an information carrier, for use with a curriculum management system that manages a curriculum comprised of at least a course, the computer program product being operable to cause data processing apparatus to perform operations, wherein:

- (a) the modification comprises canceling the course; (Column 8, lines 40-43 and Column 14, lines 57-61)
- (b) the course belongs to a sequence of courses within the curriculum; (Column 8, lines 40-43 and Column 14, lines 57-61) and
- (c) if the booking is a curriculum booking, processing the modification comprises: (Column 8, lines 40-43 and Column 14, lines 57-61)
 - (i) canceling the course; (Column 8, lines 40-43) and
 - (ii) canceling any other courses that are later in the sequence than the course. (Column 8, lines 40-43)

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. **Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schloss in view of The Columbia Institute e-Campus School Policy Manual November 2002 (hereafter referred to as Columbia).**

20. In regards to **Claims 7 and 15**, Schloss does not explicitly disclose following-up on a booking after an entire curriculum has been completed, however, Columbia teaches:

A computer program product, tangibly embodied in an information carrier, for use with a curriculum management system that manages a curriculum comprised of at least a course, the computer program product being operable to cause data processing apparatus to perform operations, wherein

(a) the modification comprises follow-up; (Page 2, line 1-2) and
(b) if the booking is a curriculum booking, processing the modification comprises: not performing the follow-up until the entire curriculum has been completed. (Page 2, line 1-2)

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Schloss so as to have included the following-up on a booking after an entire curriculum has been completed taught by Columbia in order to ensure usability by keeping accurate records of course completions, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

21. In regards to **Claims 8 and 16**, Schloss does not explicitly disclose following-up on a booking before a curriculum has been completed, however, Columbia teaches teaches:

A computer program product, tangibly embodied in an information carrier, for use with a curriculum management system that manages a curriculum comprised of at least a course, the computer program product being operable to cause data processing apparatus to perform operations, wherein

- (a) the modification comprises follow-up; (Page 2, line 1-2) and
- (b) if the booking is a curriculum booking, processing the modification comprises: performing the follow-up even if the entire curriculum has not been completed. (Page 2, line 1-2)

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Schloss so as to have included the following-up on a booking before a curriculum has been completed taught by Columbia in order to ensure compliance to curriculum rules ensuring that all requirements are met prior to giving credit for curriculum completion, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Examiner notes that according to the specification (page 1, line 26) a curriculum may consist of only one course.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lacy et al. (Patent Number 6,016,335), Eisendrath et al. (Patent No. US 6,347,333 B2), Wandmacher et al. (Patent No. US 6,990,465 B1), and Papadopoulos (Patent Number 6,099,320).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. S./

Art Unit: 3629

Examiner, Art Unit 3629

January 22, 2009

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629